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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/084,791

02/25/2002

Mark Madison Engleman

7982

7590  
Mark Engleman  
607 East Reserve Street  
Vancouver, WA 98661

10/09/2007

EXAMINER

BOYCE, ANDRE D

ART UNIT

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3623

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/084,791	ENGLEMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Andre Boyce	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-8 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This Final office action is in response to Applicant's amendment filed July 10, 2007. Claims 1-3 have been canceled. Claims 6-8 have been added. Claims 4-8 are pending, however claims 4 and 5 have been withdrawn from consideration.
2. The previously pending objection to the oath or declaration has been withdrawn.  
The previously pending objection to the abstract has been withdrawn.  
The previously pending objections to claims 1-2 have been withdrawn.  
The previously pending rejections to claims 1-3 under 35 USC § 112, second paragraph have been withdrawn.

### ***Oath/Declaration***

3. The oath or declaration filed June 27, 2006 is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.  
The oath or declaration is defective because: It was not executed in accordance with either 37 CFR 1.66 or 1.68 (i.e., it was not signed by both inventors).

### ***Priority***

4. The Examiner acknowledges Applicant's priority to provisional application number 60/271,508 filed February 23, 2001, however the provisional application is

not recognized as being a priority application for this current nonprovisional application (10/084791), in the USPTO system. Appropriate correction is requested.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "115" in Figure 2.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code, as seen, at least on page 3 of the

specification, lines 2, 4, 6, and 12. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al (The Information System Consultant's Handbook, December 1998).

As per claim 6, Davis et al disclose a method for planning and executing a business software planning and management process applicable to a company or organization (i.e., analysis and design of information systems, including software, §1.4.1, pages 5 and Figure 1.3), the method comprising the steps of: Profiling the said company's business software requirements (i.e., problem definition, wherein the problems are identified, cause determined, and strategy outlined for solving problems, §1.4.4, page 7) to generate a list of prioritized actions and issues applicable to improving the said company's said business software (i.e., system analysis in order to determine exactly what must be done to solve the problem, § 1.4.4, page 7), and Using said business software profile and methods, effecting improvement actions for said business, including improving existing business

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software, selecting and implementing new business software (i.e., system development, wherein solutions are implemented, § 1.4.4, page 8).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al (The Information System Consultant's Handbook, December 1998), in view of Bruce (USPN 7,117,161).

As per claim 7, Davis et al does not explicitly disclose (a) using said weighted priorities that are specific to said particular organization, review the capability for a specific said business software to meet each said weighted priority using the following three criteria, each with standard answer codes, 1) if, and how, the said weighted priority is achieved, 2) if achieved, how well is the said weighted priority achieved, and 3) the said particular organization's confidence in collected information about the capability for a specific said business software to meet a specific said weighted priority, (b) a calculation for each said business software comprised of an aggregate score developed from a numeric value of said weighting from each said weighted priority and numeric values for each said weighted priorities' said answers, using said standard answer codes, to the following said

criteria 1) if, and how, the said priority is achieved, 2) if achieved, how well is the said priority achieved.

Bruce discloses a process to achieve desired goals, wherein the primary process flow is identified, along with the drivers of the process flow, the metrics of the drivers and how the driver relate to the key performance indicators, KPI, (column 7, lines 27-44). In addition, Bruce discloses decisions made within an organization to achieve its goals, wherein the business system may be organized into different process flows for achieving the goals (column 21, lines 40-67), wherein the process flows are weighted differently in terms of their importance (column 23, lines 61-67). Moreover, Bruce discloses determining the effectiveness of the process flows by measuring the KPIs (column 21, lines 5-21). Both Davis et al and Bruce are concerned with effective analysis of information system development, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include using said weighted priorities that are specific to said particular organization, review the capability for a specific said business software and a calculation for each said business software comprised of an aggregate score in Davis et al, as seen in Bruce, since a person with ordinary skill has good reason to pursue the known options within his or her technical grasp.

As per claim 8, Davis et al does not explicitly disclose (a) using said business process support objectives that are relevant to said particular organization, review each said business process support objective and the ability of said business software to achieve said business process support objective and determine the

answers to the following criteria, each with standard answer codes, 1) can the said business process support objective be achieved by the said business software, 2) said particular organization's confidence in the answer code to the criteria, can the said business process support objective be achieved by the said business software, 3) if the said business process support objective is achievable by the said business software, to what level is the said business process support objective is being met by the said business software, (b) manage said effort to implement and further implement said business software by using said attributes and said answer codes to locate the most appropriate said business process support objectives to implement with said business software, (c) develop implementation progress statistics over time for one or aggregated organizations, such as said particular organization, comprised of an aggregate calculated score developed from a weighting and non-weighted numeric values for each said business process support objective and numeric values for the criteria, 1) can the said business process support objective be achieved by the said business software, 2) if the said business process support objective is achievable by the said business software, to what level is the said business process support objective is being achieved.

Bruce discloses a process to achieve desired goals, wherein the primary process flow is identified, along with the drivers of the process flow, the metrics of the drivers and how the driver relate to the key performance indicators, KPI, (column 7, lines 27-44). In addition, Bruce discloses decisions made within an organization to achieve its goals, wherein the business system may be organized into different



process flows for achieving the goals (column 21, lines 40-67), wherein the process flows are weighted differently in terms of their importance (column 23, lines 61-67). Moreover, Bruce discloses determining the effectiveness of the process flows by measuring the KPIs (column 21, lines 5-21). Both Davis et al and Bruce are concerned with effective analysis of information system development, therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include business process support objectives that are relevant to said particular organization, manage said effort to implement and further implement said business software by using said attributes, and develop implementation progress statistics over time for one or aggregated organizations in Davis et al, as seen in Bruce, since a person with ordinary skill has good reason to pursue the known options within his or her technical grasp.

### ***Conclusion***

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing


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date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571) 272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
adb  
October 1, 2007

  
ROMAIN JEANTY  
Primary Examiner A.U. 3623